

SUPPORT FOR THE AMENDMENT

Claims 6 and 12-15 were previously canceled.

Claims 1, 4, and 7 have been amended.

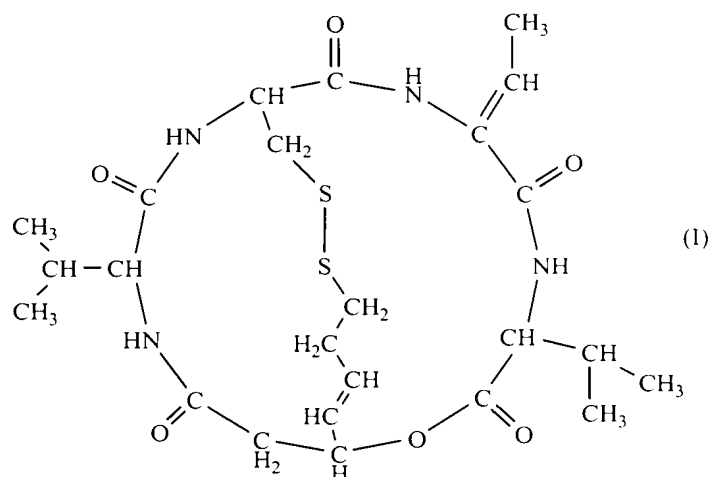
Support for the amendment to Claims 1, 4, and 7 is provided by original filed Claims 1, 4, and 7, as well as the specification throughout. Claim 7 has been amended to depend from Claim 4 since Claim 6 has been canceled.

No new matter has been entered by the present amendment.

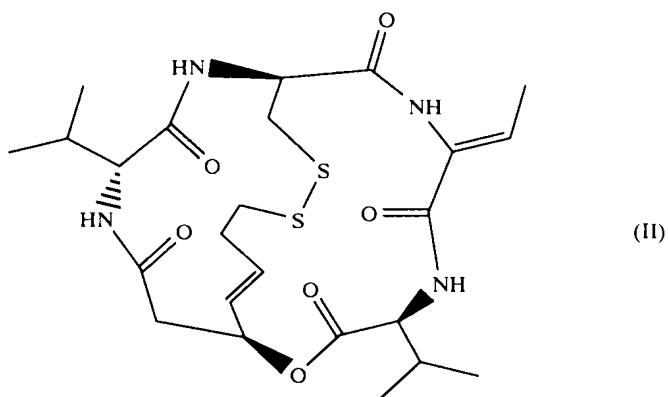
## REMARKS

Claims 1-5 and 7 are the only claims pending in the above-identified application that are currently subject to examination. All other claims, whether original or added during prosecution, were canceled during prosecution of this application or stand withdrawn.

Independent Claim 1 provides a method for treating kidney cancer in a mammal in need thereof, which comprises administering an effective amount of a compound of the formula (I)

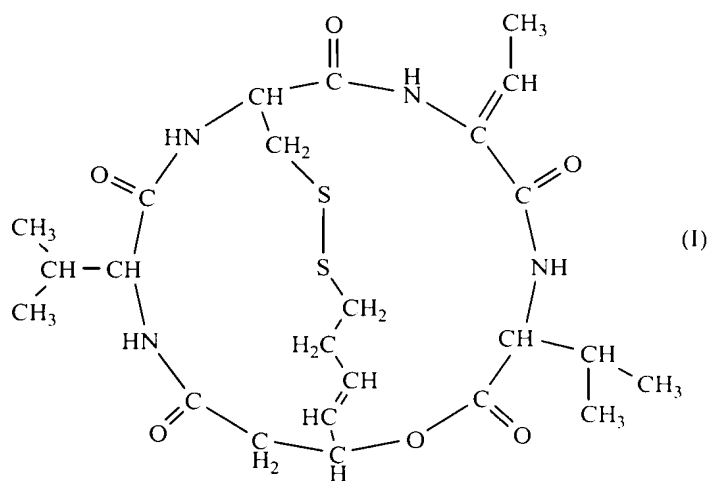


or a salt thereof to said mammal. Claim 2 (dependent upon Claim 1) further defines the compound represented by the formula (I) as being a compound represented by formula (II)

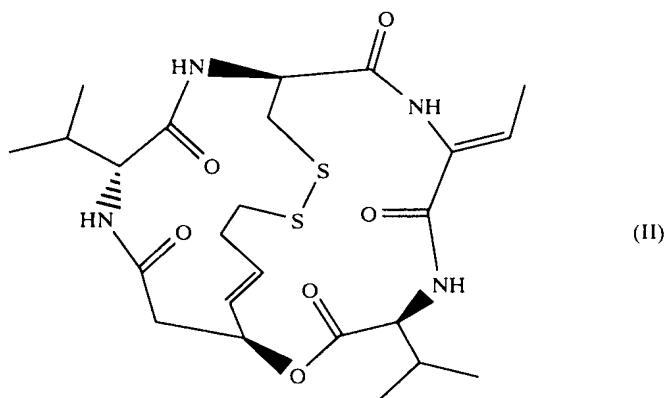


(see the specification, at least, at page 3, line 4 to page 4, line 1, page 8, line 16 to page 10, line 17, page 10, line 29 to page 11, line 19, and the Examples, for example, Example 1 and Figure 1 and Example 2).

Independent Claim 4 provides a method of suppressing growth of a cancerous tumor of the kidney *in vivo* in a mammal in need thereof, which comprises administering an effective amount of a compound of the formula (I)



or a salt thereof to said mammal. Claim 5 (dependent upon Claim 4) further defines the compound represented by the formula (I) as being a compound represented by formula (II)



and Claim 7 (dependent upon Claim 4) further defines “*in vivo*” and the mammal (see the specification, at least, at page 4, line 4 to page 5, line 1, page 8, line 16 to page 10, line 25,

page 10, line 29 to page 11, line 19, and the Examples, for example, Example 1 and Figure 1 and Example 2).

A. Claims 1-5 and 7 stand rejected under 35 U.S.C. §103(a) over Nakajima et al<sup>1</sup> in view of Georges et al<sup>2</sup> and Ueda et al.<sup>3</sup> This rejection is untenable and should be withdrawn.

It is the Examiner's position that Nakajima et al discloses a compound of formula (I) and (II) (i.e., FK228) as an inhibitor of intracellular histone deacetylase activity that strongly inhibits proliferation of tumor cells *in vitro* and greatly suppresses the growth of transplanted tumors in mice (citing page 126). However, the Examiner recognizes that Nakajima et al fail to specifically disclose the treatment of kidney cancer or suppression of a cancerous tumor in the kidney.

Ueda et al disclose that FR901228 shows the suppression of the proliferation of tumor cells not only *in vitro* but also in SRC assay using A549 lung adenocarcinoma or MCF-7 mammary adenocarcinoma, as shown in Table III on page 308.

This distinction in the claims is further enhanced by the amendment herein to require that the mammal to which FK228 is administered for the purpose of treating kidney cancer or suppressing growth of a cancerous tumor of the kidney *in vivo* is a mammal "in need thereof." The U.S. Courts have held that a method of administering a compound "to a human in need thereof" is properly construed to require that the compound be administered to human with a recognized need to treat the recited disorder or to bring about the recited effect (*Jansen v. Rexall Sundown Inc.*, 342 F.3d 1329, 1332, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)). Thus, in the claimed invention, the "subject in need thereof" is a mammal with a recognized

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<sup>1</sup> Experimental Cell Research (1998) 24: 126-133.

<sup>2</sup> US 2002/0065282.

<sup>3</sup> J. Antibiot. (1994) 47: 301-310.

need for treatment of kidney cancer or suppressing growth of a cancerous tumor of the kidney in vivo. This sub-set of patients is not disclosed by Nakajima et al, Georges et al, and Ueda et al.

With regard to Georges et al, the Examiner states, “Georges et al. teaches a method of treating the proliferation of malignant cell and cancer of the breast, ... as well as solid tumors of kidney, ... , with a histone deacetylase inhibitor.” With respect to the allegations related to Georges et al in particular, Applicants disagree with the Examiner’s allegations.

Notably, Georges et al discloses that an unrelated collection of compounds have been found to possess anti-cell-proliferation properties arising from their histone deacetylase inhibitory activity (see paragraph [0036]). Georges et al then concludes that due to the anti-cell-proliferation properties, their compounds “are expected to be useful in the treatment of cancer... particularly in the treatment of cancers of the breast, lung, colon, rectum, stomach, prostate, bladder, pancreas, and ovary.” Georges et al further speculate that “[i]t is in addition expected that a derivative of the present invention will possess activity against a range of leukemias, lymphoid malignancies and solid tumors such as carcinomas and sarcomas in tissues such as the liver, kidney, prostate and pancreas” (see paragraph [0036]).

Accordingly, it must be noted that Georges et al provides nothing more than mere speculation of an unsupported “expectation” that their compounds would work for treating virtually any form of cancer. Certainly, this does not provide any reasonable expectation that the structurally distinct compounds used in the present methods would be successful for treating kidney cancer. At best, Georges et al provides nothing more than a hope that the HDAC inhibitors disclosed therein can cure or treat every known form of cancer without sufficient evidence to support the enablement of any HDAC inhibitors, in particular FK228, for the treatment of kidney cancer.

Georges et al disclose HDAC inhibitory activity (Example 12) of the compound of the formula I (a compound which is structurally unrelated to Applicant's compound), but does not disclose or suggest suppression of proliferation of malignant cell in any cancer, nor does it show any pharmacological data supportive of such effect.

Indeed, at no point do Georges et al disclose or suggest that an HDAC inhibitor suppresses kidney cancer nor do Georges et al provide any reference citation that discloses the same. Certainly, it is curious that the Examiner could maintain that there is a reasonable expectation of success for treating kidney cancer where the disclosure relied upon offers no evidence to support anything other than unrelated forms of cancer. It is beyond question in cancer therapeutics that different forms of cancer require different drugs. In other words, there is no one drug or class of drugs that can treat any and all forms of cancer. Indeed, one of ordinary skill in the art would not have a reasonable expectation that a drug that treats breast cancer would also have efficacy for treating kidney cancer.

In the "Background Of The Invention" (on last 6 lines of paragraph 1 on page 1), Georges et al disclose that an HDAC inhibitor has already been found to suppress proliferation of colon cancer, T-cell lymphoma and erythroleukemic cells. As a review of the HDAC inhibitor, Georges et al cites Marks et al, J. Natl. Cancer Inst. 92 (15), 1210-1216, (2000) (paragraph 2 on page 1; copy submitted with the response filed on December 31, 2008). The Marks et al reference reports *in vivo* pharmacological test results including clinical tests of various HDAC inhibitors (see, the second paragraph, "In Vivo studies With HDAC Inhibitor" on page 1214). According to Marks et al, pharmacological tests using animal models were performed for plural HDAC inhibitors, and suppression of the proliferation of tumors such as breast, prostate, lung and the like was observed. However, no report refers to kidney cancer and the potential efficacy of any HDAC inhibitor for this

indication. In the second paragraph, where two other HDAC inhibitors are mentioned, it again fails to describe HDAC inhibitor activity against kidney cancer.

The Examiner's general position with respect to the disclosure of Georges et al on page 3, paragraph 36, lines 10-19, is based on the expectation that, given the HDAC inhibitory activity confirmed in the compound of the formula I, combined with the finding relating to known HDAC inhibitors, the compound of the formula I must similarly have an anti-proliferative effect. However, as described above, the type of cancer recited in the cited references includes, in addition to those cancers for which other known HDAC inhibitors have already been confirmed to be effective, kidney cancer on which no report was found at the time of filing of the application. Kidney cancer is not at all the type of cancer for which an effect is "expected" from the findings of known HDAC inhibitors. Inasmuch as Georges et al do not disclose a basis for the expectation of an effect for kidney cancer, no such conclusion can be reasonably drawn from Georges et al. Therefore, Applicants submit that the Examiner's allegation that Georges et al disclose an effect for treating kidney cancer is incorrect.

The Examiner disregards the foregoing and alleges "Georges et al provides the motivation to try other HDAC inhibitors to treat other cancers, such as kidney cancer... The expectation of success is that a mechanism of action has been established between HDAC inhibitors and several cancers." Applicants disagree with this allegation for reasons discussed above. Applicants' clear showing that success with treatment of one cancer does not portend of success of any and all types of cancer has not been rebutted by any evidence offered by the Examiner.

It appears that it is the Examiner's position is that the combined disclosures could be taken as an "invitation to experiment" or could be viewed as providing an "obvious to try"

argument; however, “obvious to try” has long been held *not* to constitute obviousness. *In re O'Farrell*, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995).

*KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007) does not eliminate the “obvious to try is not obvious” standard, as it clearly states that “obvious to try” may constitute obviousness, but only under certain circumstances. Specifically, *KSR* stated that the fact that a claimed combination of elements was “obvious to try” might show that such combination was obvious under 35 U.S.C. § 103, since, if there is design need or market pressure to solve problem, and there are finite number of identified, predictable solutions, person of ordinary skill in art has good reason to pursue known options within his or her technical grasp, and if this leads to anticipated success, it is likely product of ordinary skill and common sense, not innovation. However, the Examiner offers nothing to show how these factors apply and whether there would be such an expectation or anticipated success.

Applicants respectfully submit that the Examiner has not offered any evidence that there is a recognized “design need or market pressure to solve the problem.” Indeed, the art makes no suggestion that such a need even exists. Further, the Examiner fails to show that there are a “finite number of identified, predictable solutions.” The Examiner also does not provide any evidence that a “person of ordinary skill in art has good reason to pursue known options within his or her technical grasp.”

Indeed, absent Applicants’ disclosure to serve as the guidepost, no objective reason to combine the teachings in a way that would place the artisan in possession of the claimed invention can be found. Indeed, Applicants again submit that the skilled artisan would appreciate that sensitivity to anti-tumor agents varies depending on the type of cancer, and



the type of cancer that proves effective should be ascertained by panel tests and the like. Likewise, the sensitivity to HDAC inhibitors, including toxicity, has also been studied. For example, as shown in Nishimura et al., page 556, Table 4, submitted on April 30, 2008, those having ordinary skill in the art usually perform *in vivo* cancer proliferation suppression tests (sensitivity tests) with regard to the target cancer, so as to know what site or which type of cancer an anti-tumor agent is effective for. As shown in Table 4 of FR900840 cited in Nishimura et al., each anti-tumor agent is known to show different effects depending on the tumor site and the type of tumor cells. Hence, the effect of an HDAC inhibitor for kidney cancer cannot be predicted even when some references (Nakajima et al. and Ueda et al.) disclose that the HDAC inhibitor is effective for other types of cancer, since no other HDAC inhibitors have exhibited an effect for kidney cancer, and therefore, no motivation can be found to apply the HDAC inhibitor to kidney cancer.

Applicants again strongly argue that it is not proper to conclude, “use for the treatment of kidney cancers is enough for a skilled practitioner to obviously try” with regard to the compound of the present invention. The reasons, therefore, are that Georges et al only provide a broad disclosure with a desirous effect of the compound but without a support for the alleged effect, the present compound has a completely different structure, and that the mere presence of the same mechanism is not sufficient to reach a conclusion of efficacy.

Further, Applicants again wish to direct the Examiner’s attention to the specification at page 2, lines 2-7, which provides a general view of the state of the art at the time of the present invention stating:

As the situation stands, however, there are many problems yet to be solved, such as effectiveness of *in vitro* results in *in vivo* application, *in vivo* effectiveness against any tumor and the like. The antitumor activity *in vitro* against kidney cancer has been reported, but an antitumor activity *in vivo* against kidney cancer has not been reported.

Based on the foregoing, Applicants submit that there is no direct expectation of *in vivo* efficacy from the *in vitro* observation of HDAC inhibitory activity. This lack of expectation of success is clearly manifest in the combined disclosures of Nakajima et al and Georges et al. Nonetheless, the Examiner again states on page 11 of the Office Action, “In regards to expectation of success for *in vivo* efficacy based on *in vivo* data, the prior art demonstrates that *in vitro* data does relate to efficacy of kidney tumors *in vivo*, as taught by Ueda et al.” The Examiner’s opinion seems to involve a misunderstanding, as described below.

The Examiner appears to rely on Ueda’s study of compound activity *in vivo*. However, Applicants respectfully submit that the cell lines used in this *in vivo* study are A549 and MCF-7, which are human **lung** adenocarcinoma and human **mammary** adenocarcinoma respectively (Ueda et al, paragraph bridging pages 303-304). Further, the above-referenced text clearly states that these cells were transplanted **under** the kidney capsule of BDF1 mice. Thus, none of these experiments provide any suggestion to **treat kidney cancer** or any expectation of the efficacy when so doing. Therefore, Ueda et al does nothing to compensate for the deficiency in the combined disclosures of Nakajima et al and Georges et al.

The Examiner is further reminded that lung cancer cell lines, breast cancer cell lines, and kidney cancer cell lines are distinct. As such, just because a breast cancer cell is grown on the kidney does not instantly make it “kidney cancer.” It remains a breast cancer cell that is grown on the kidney. Further, the following is found in Ueda et al on page 303, lines 6-4 from the bottom, which clarifies that the *in vivo* test uses the method of Nishimura et al called an SRC assay:

“In Vivo Antitumor Activity of FR901228

A two-week Subrenal Capsule (SRC) assay using the immunosuppressive agent FK-506 was performed according to the method described by Nishimura et al.<sup>17,18)</sup>”

In response, Applicants submitted with the Amendment filed April 30, 2008 the following references:

Nishimura et al, The Journal of Antibiotics Vol. XLII No. 4 (April 1989): 553-557;  
Abstract of Gan to Kagaku Ryoho, 1987 May; 14 (5 Pt 2): 1629-35; and  
Bogden et al, Exp Cell Biol. 1979; 47(4): 281-93.

In Nishimura et al., the Subrenal Capsule (SRC) Assay is described on page 555. In addition, Gan to Kagaku Ryoho, 1987 May; 14 (5 Pt 2): 1629-35 and Exp Cell Biol. 1979; 47(4): 281-93 discuss the SRC Assay. These references teach that the SRC Assay is a sensitivity test (chemosensitivity test) of anticancer drugs and, by comparison with a subcutaneous transplantation assay in nude mice, they state that the tumor growth inhibition rates of the SRC assay were corrected well with the clinical responses.

Therefore, it will be understood that the SRC Assay is a sensitivity test for rapid evaluation of a clinical affect of an anticancer drug for various tumors. While a tumor is implanted under the kidney capsule in the test of Ueda et al, this is clearly not for the evaluation of the effect on kidney cancer, but for the evaluation of the clinical effect of the compound on the implanted tumor itself (i.e. lung or mammary). It remains that Ueda et al do not at all suggest the efficacy for kidney tumors *in vivo*.

With respect to Bogden et al, the Examiner is referred to the Discussion on page 290, which discloses that an environment promoting the growth of xenografts (namely, human cancer cells) is present in the subrenal capsule site (first paragraph), and that the xenograft itself can be visualized due to the transparency of the renal capsule (third paragraph). It is therefore clear that the SRC technique is a useful test method for measuring the growth of the implanted human cancer cells, utilizing the environment of the subrenal capsule site. In addition, the fourth paragraph on page 291 discloses that this method enables screening of

drugs against a wider range of human tumor systems, and also enables evaluation of organ specificity as well as clinical potential. In contrast, no disclosure is found which indicates or suggests formation of kidney cancer in the subrenal capsule by the human cancer cell implanted by this method, as alleged by the Examiner.

Further, in the Results on page 284 of Bogden et al, the growth of human cancer cells implanted under the renal capsule is disclosed in Figs. 1-6, where the results obtained by this test method concern growth of the implanted human cancer cells. Nishimura et al, The Journal of Antibiotics Vol. XLII No. 4 (April 1989): 553-557, describe in Activity against Human Xenograft Tumors on page 556 that the anticancer activity of FR900840 against 10 kinds of human cancers was evaluated by this test. Therefore, those skilled in the art understand that the SRC technique is a test method for evaluating anticancer activities of a drug against implanted human cancer cells, and even if the site of cell implantation is under the renal capsule, they obviously do not consider that the technique evaluates action on kidney cancer.

Furthermore, Nishimura et al, The Journal of Antibiotics Vol. XLII No. 4 (April 1989): 553-557 disclose on page 556, Table 4 and in lines 10 to 3 from the bottom that an *in vivo* test was performed using the FR900840 compound against 10 different tumors and the results fail to show activity of the compound in certain kinds of tumors. This suggests that the activity of a compound against a tumor cannot be predicted based only on an *in vivo* activity of the compound against a different kind of tumor. Therefore, contrary to the Examiner's allegation, the skilled artisan would not reasonably expect that the present compound would treat a tumor in the kidney *in vivo* based on the disclosure of Ueda et al.

It is further submitted that the presently claimed invention is drawn to an *in vivo* method. The Examiner recognizes that "Nakajima et al. and Georges et al. do not teach the

Applicant's compound used *in vivo* or in a human." Thus, for the reasons given above, the presently claimed invention is not obvious from the combined disclosures of Nakajima et al and Georges et al.

In the present invention, the claimed compound was first found to be an HDAC inhibitor effective for kidney cancer, where the usefulness of the compound was confirmed *in vivo* using animal models, as well as through clinical tests in human. Such an effect for kidney cancer was not determined with the many known HDAC inhibitors prior to the present invention. Since a clinical effect was confirmed for the *first* time in the present invention, the present invention is not obvious in view of the combined disclosures of Nakajima et al, Georges et al and Ueda et al.

Accordingly, it is respectfully requested that this rejection be withdrawn.

**B.** Claims 1-5 and 7 stand provisionally rejected under the doctrine of obviousness-type double patenting over Claims 48, 50, 54, and 55 of co-pending application No. 11/064,292 in view of Georges et al and Ueda. This rejection is untenable and should be withdrawn.

The Examiner is reminded that the present application has an earlier effective filing date than US 11/064,292. Accordingly, if a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. (MPEP §804(I)(B)(1)).

C. Claims 1-5 and 7 stand rejected under the doctrine of obviousness-type double patenting over Claims 11-13 of US 7,314,862 in view of Georges et al and Ueda. This rejection is untenable and should be withdrawn.

Noting that the present application has an earlier effective filing date than US 7,314,862, Applicants traverse this rejection at least on the grounds that the Examiner has not properly rejected the claims by failing to use the two-way obviousness determination.

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Where an application is rejected under the doctrine of obviousness-type double patenting over an issued patent and the patent is the *later filed* application, the question of whether the timewise extension of the right to exclude granted by a patent is justified or unjustified must be addressed.

A two-way test of obviousness is to be applied only when the applicant could not have filed the claims in a single application *and* there is administrative delay. *In re Berg*, 46 USPQ2d 1226 (Fed. Cir. 1998). In the absence of administrative delay, a one-way test is appropriate. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993). Unless the record clearly shows administrative delay by the Office and that applicant could not have avoided filing separate applications, the examiner may use the one-way obviousness determination and shift the burden to applicant to show why a two-way obviousness determination is required. (see MPEP §804(II)(B)(1)(b)).

As stated above, the present application has an effective filing date prior to US 7,314,862. Accordingly, the present application was the first filed application (i.e., has the earlier effective U.S. filing date). The present application does not provide a sufficient

written description of the method presented in US 7,314,862 (i.e., no disclosure of doxorubicin) and, therefore, the claims of US 7,314,862 could not have been presented in the first application filed. Accordingly, the first prong of the *In re Berg* test is satisfied.

With respect to administrative delay, the Office cautions that although a delay in the processing of applications before the Office that would cause patents to issue in an order different from the order in which the applications were filed is a factor to be considered in determining whether a one-way or two-way obviousness determination is necessary to support a double patenting rejection, it may be very difficult to assess whether an applicant or the administrative process is primarily responsible for a delay in the issuance of a patent (see MPEP §804(II)(B)(1)(b)). In this case, where, through no fault of the applicant, the claims in a later filed application issue first, an obvious-type double patenting rejection is improper, in the absence of a two-way obviousness determination, because the applicant does not have complete control over the rate of progress of a patent application through the Office. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991). Indeed, Applicants have proceeded with reasonable diligence toward obtaining allowance in this case and the Examiner continues to present the same, or similar, rejections. Thus, the delay in obtaining allowance of this application is deterred by the Office, not Applicants. As such, there is an administrative delay and the second prong of the *In re Berg* test is satisfied.

If the Examiner uses a two-way obviousness determination, it is necessary to apply the *Graham* obviousness analysis twice, once with the application claims as the claims in issue, and once with the patent claims as the claims in issue. Where a two-way obviousness determination is required, an obvious-type double patenting rejection is appropriate only where each analysis compels a conclusion that the invention defined in the claims in issue is an obvious variation of the invention defined in a claim in the other application/patent. If

either analysis does not compel a conclusion of obviousness, no double patenting rejection of the obvious-type is made.

Claims 11-13 of US 7,314,862 are directed to a composition comprising a compound of the formula (I) and doxorubicin, as well as to a method of treating cancer including kidney cancer, which comprises administering the composition. None of the claims of US 7,314,862 remotely suggest the effect on kidney cancer of the compound of formulae (I) in the *absence* of doxorubicin. Hence, the presently claimed subject matter directed to treating kidney cancer or suppressing growth of a cancerous tumor of the kidney in vivo in a mammal with FK228 is not obvious in view of the claims of US 7,314,862 even when viewed with Georges et al and Ueda for the same reasons that the Examiner's rejection over the disclosures of Nakajima et al, Georges et al, and Ueda is improper. Further, the claimed method, which comprises administering the compound of the formula (I) or (II) per se, is not obvious from the method claim of US 7,314,862, which require the presence of doxorubicin. Thus, this rejection fails in both directions of the two-way obviousness determination.

Accordingly, it is respectfully requested that this rejection be withdrawn.

**D.** Claims 1-5 and 7 stand provisionally rejected under the doctrine of obviousness-type double patenting over Claims 45 and 60 of co-pending application No. 10/486,833 in view of Georges et al. This rejection is untenable and should be withdrawn.

Claims 45 and 60 of US 10/486,833 relate to a method of treating prostate cancer, not kidney cancer. The Examiner alleges that Georges et al. compensates for this deficiency. Applicants disagree.

Again, Applicants submit that there is nothing obvious about a method of treating kidney cancer and/or a method of suppressing growth of a cancerous tumor of the kidney in



vivo in mammals (the claimed invention) from the claims of US 10/486,833 drawn to a method of treating prostate cancer. Indeed, prostate cancer and kidney cancer are two distant and unrelated cancers and the claims of US 10/486,833 and Georges et al fail to provide any reasonable expectation of success in treating kidney cancer.

Indeed, this distinction in the claims is further enhanced by the amendment herein to require that the mammal to which FK228 is administered for the purpose of treating kidney cancer or suppressing growth of a cancerous tumor of the kidney in vivo is a mammal "in need thereof." The U.S. Courts have held that a method of administering a compound "to a human in need thereof" is properly construed to require that the compound be administered to human with a recognized need to treat the recited disorder or to bring about the recited effect (*Jansen v. Rexall Sundown Inc.*, 342 F.3d 1329, 1332, 68 USPQ2d 1154, 1158 (Fed. Cir. 2003)). Thus, in the claimed invention, the "subject in need thereof" is a mammal with a recognized need for treatment of kidney cancer or suppressing growth of a cancerous tumor of the kidney *in vivo*. This sub-set of patients is not disclosed by US 10/486,833 and Georges et al.

As set forth above in Argument (A), Georges et al discloses that an unrelated collection of compounds have been found to possess anti-cell-proliferation properties arising from their histone deacetylase inhibitory activity (see paragraph [0036]). Georges et al then concludes that due to the anti-cell-proliferation properties, their compounds "are expected to be useful in the treatment of cancer... particularly in the treatment of cancers of the breast, lung, colon, rectum, stomach, prostate, bladder, pancreas, and ovary." Georges et al further speculate that "It is in addition expected that a derivative of the present invention will possess activity against a range of leukemias, lymphoid malignancies and solid tumors such as carcinomas and sarcomas in tissues such as the liver, kidney, prostate and pancreas" (see

paragraph [0036]). Accordingly, it must be noted that Georges et al provides nothing more than mere speculation of an unsupported “expectation” that their compounds would work for treating virtually any form of cancer. Certainly, this does not provide any reasonable expectation that the compounds of the presently claimed invention would be successful for treating kidney cancer.

Georges et al disclose HDAC inhibitory activity (Example 12) of the compound of the formula I (compounds structurally unrelated to the compound used in the present methods), but does not disclose or suggest suppression of proliferation of malignant cell in any cancer, nor does it show any pharmacological data supportive of such effect.

Indeed, at no point do Georges et al disclose or suggest that HDAC inhibitor suppresses kidney cancer nor do Georges et al provide any reference citation that discloses the same. In the “Background Of The Invention” (on last 6 lines of paragraph 1 on page 1), Georges et al disclose that an HDAC inhibitor has already been found to suppress proliferation of colon cancer, T-cell lymphoma and erythroleukemic cells.

As a review of the HDAC inhibitor, Georges et al cites Marks et al, J. Natl. Cancer Inst. 92 (15), 1210-1216, (2000) (paragraph 2 on page 1). The Marks et al reference reports *in vivo* pharmacological test results including clinical tests of various HDAC inhibitors (see, the second paragraph, “In Vivo studies With HDAC Inhibitor” on page 1214). According to Marks et al, pharmacological tests using animal models were performed for plural HDAC inhibitors, and suppression of the proliferation of tumors such as breast, prostate, lung and the like was observed. However, no report refers to kidney cancer and the potential efficacy of any HDAC inhibitor. In the second paragraph, two other HDAC inhibitors are mentioned, which again fail to describe HDAC inhibitor activity against kidney cancer.

The Examiner's general position with respect to the disclosure of Georges et al on page 3, paragraph 36, lines 10-19, is based on the expectation that, given the HDAC inhibitory activity confirmed in the compound of the formula I, combined with the finding relating to known HDAC inhibitors, the compound of the formula I must similarly have an anti-proliferative effect. However, as described above, the type of cancer recited in the cited references includes, in addition to those cancers for which other known HDAC inhibitors have already been confirmed to be effective, kidney cancer on which no report was found at the time of filing of the application. Kidney cancer is not at all the type of cancer for which an effect is "expected" from the findings of known HDAC inhibitors. Inasmuch as Georges et al do not disclose a basis for the expectation of an effect for kidney cancer, no such conclusion can be reasonably drawn from Georges et al. Therefore, Applicants submit that the Examiner's allegation that Georges et al disclose an effect for treating kidney cancer is incorrect.

As such, Applicants submit that the presently claimed subject matter directed to the method claim of treating kidney cancer of the present invention, which comprises administering the compound of the formula (I) or (II), is not obvious from the methods claimed in US 10/486,833 in view of Georges et al.


Accordingly, it is respectfully requested that this rejection be withdrawn.

Applicants submit that the present application is now in condition for allowance.

Early notification of such action is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.  
Norman F. Oblon

A handwritten signature in black ink, appearing to read 'V. Shier', is written over the printed name of Vincent K. Shier.

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